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10/681,974	10/09/2003	Toshio Yamamoto	VTN629NP	7789
27777	7590	12/13/2007	EXAMINER	
PHILIP S. JOHNSON			PORTER, RACHEL L	
JOHNSON & JOHNSON			ART UNIT	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/681,974

Applicant(s)

YAMAMOTO ET AL.

Examiner

Rachel L. Porter

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 06 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed on 6/6/07. Claims 18-32 are pending in the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 18-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of claim 18 recites "an online method of supplying contact lenses to a patient". However, at no point in the recited method of claim 18 is a patient supplied with contact lenses.

Claim 23 recites the limitation "receiving into the online system a patient." It is unclear to the Examiner how the system "receives a patient" into the system. For examination purposes, the Examiner will interpret this phrasing to mean that the system accepts some form of patient identifier or information.

Claim 24 inherits the deficiencies of claim 23 through dependency, and is also rejected.

Response to Arguments

4. Applicant's arguments with respect to claims 18-32 have been considered but are moot in view of the new ground(s) of rejection.

5.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 18-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi (P2002-170008A) in view of Broderick et al (US 2004/0176977 A1)

[claim 18] Takahashi discloses an online method of supplying contact lenses to a patient, the method comprising the steps of:

- receiving into an online system data identifying an authorized reseller; (par. 17, 22,30)
- receiving into the online system a rule to be applied for calculations of a suggested quantity of contact lenses; (par. 35, 38-40)
- receiving into the online system from the authorized reseller a price to charge a consumer for a specific quantity of a particular contact lens; (par. 35, 37)

- receiving into the online system a prescription for the consumer to receive the particular contact lens, (par. 17, 32) wherein the prescription is authorized by the oculist and comprises a lens brand and a prescription date; (par. 33,35)
- automatically calculating a suggested quantity of contact lenses based upon the lens brand, the prescription date and the rule to be applied to calculations for a suggested quantity of contact lenses; (par. 17, 35,38-39)
- receiving into the online system an order from the authorized reseller for the consumer to receive a specific quantity of the particular contact lens; (par. 38)
- ascertaining that the specific quantity of ordered contact lenses does not exceed the automatically calculated suggested quantity of contact lenses; (par. 39-40)
- charging the consumer for the order based upon the price to charge for a specific quantity of a particular contact lens; and (par. 35)
- generating delivery instructions to ship the particular contact lenses directly to the consumer. (par.17, 36)

Takahashi discloses the method as described above, but does not expressly disclose receiving into the online system data identifying an oculist. Takahashi further does not disclose that the prescription authorized by the oculist includes lens power, and lens diameter.

Broderick discloses an online system and method for ordering for contact lenses comprising the step of receiving into the online system data identifying an oculist; (par. 54, par. 69) and further discloses that the information in the prescription includes lens power and lens diameter. At the time of the applicant's invention, it would have been

obvious to one of ordinary skill in the art to modify the system and method of Takahashi with the teachings of Broderick to include identify provide additional information regarding the prescription (e.g. oculist identification, lens power and diameter). As suggested by Broderick, one would have been motivated to include these features to allow users to efficiently order uniquely made customized contact lenses based upon the patient's parameters and legal requirements. (Broderick: Par. 9-10)

[claim 19] Takahashi teaches a method, which additionally comprises the steps of:

- receiving into the online system data descriptive of a default prescription duration associated with the authorized reseller; (par. 39-41)
- presenting the default prescription period to the authorized reseller for the prescription; and (par. 33)
- receiving an indication of whether the authorized reseller accepts or modifies the default prescription period. (par. 33-34)

[claim 20] Takahashi disclose a method, wherein the prescription date comprises a date the prescription expires (par. 33) and the method additionally comprises the steps of: determining how many days remain until the date the prescription expires; (par. 33) determine how many days the prescribed lens is designed to be worn; (par. 35) and calculating a maximum quantity of lenses that can be ordered, based upon the number of days that remain until the date the prescription expires and the number of days the prescribed lens is designed to be worn. (par. 35,38-40)

[claim 21] Takahashi discloses a method, additionally comprising the steps of:

- receiving a rounding rule to be applied when determining a maximum quantity of lenses that can be included in an order; and (par. 38-39)
- rounding out the maximum quantity of lenses that can be ordered according to the rounding rule. (par. 40-41)

[claim 22] Takahashi teaches a method, wherein the method additionally comprises the steps of:

- receiving into the online system an order date for the order from the consumer; (par. 35-36)
- receiving into the online system special pricing available for one or more products and an indication of a time period for which the special will apply; (par. 35-36, 55 lens unit price, member pricing)
- determining if the one or more products comprise the particular contact lens ordered; (par. 35,37)
- determining the order date is within the time period for which the special pricing is available; (par. 35, 38-42)
- and charging the special pricing for the contact lenses ordered. (par. 37, 42)

[claim 23] Takahashi discloses a method wherein the method additionally comprises the steps of:

- receiving into the online system patient (information) (see 112,2nd rejection—par. 32)

- receiving into the online system an indication of the identification of an authorized reseller; and (par. 22)
- generating a notification to the authorized reseller that the patient is included on a list comprising patients awaiting contact lens prescription fulfillment. (par. 48-49)

[claim 24] Takahashi discloses a method additionally comprising the step of generating an automated notification to the consumer indicating that a prescription for contact lenses for the patient has been entered. (par. 43,49)

[claim 25] Takahashi discloses the method of claim 18 additionally comprising the steps of:

- transmitting to the consumer an indication of the suggested quantity of contact lenses and the variables used to calculate the suggested quantity; and (par. 39-40—client terminal is notified of abnormalities/problems when calculating and approving orders)
- receiving into the online system an indication from the consumer of an ordered quantity which is equal to the suggested quantity. (par. 41-42)

[claim 26] Takahashi teaches a method additionally comprising the step of calculating a schedule indicating when ordered contact lenses will be worn and when they will be discarded. (par. 39-40-determines wear schedules/whether erroneously disposes of lenses)

[claim 27] Takahashi teaches a method additionally comprising the steps of: storing in the online system a record of all prescriptions received that are associated with a specific consumer; (par. 48-49) and presenting a report indicating two or more of the prescriptions received that are associated with the specific consumer. (par. 49)

[claim 28] Takahashi discloses a method of claim 18 additionally comprising the step of processing payment for the order (par. 42-43), but does not expressly disclose that payment is processed through a third party clearing house. Broderick discloses that third party payment systems (e.g. credit card payments and insurers) are well-known in the art. (par. 60) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Takahashi using third party payment/clearinghouse. As suggested by Broderick, one would have been motivated to include this feature to provide a more convenient and secure service for recognized customers and users of the system. (par. 60) .

[claim 29] Takahashi discloses a method additionally comprising the steps of: transmitting to the consumer a suggested order; and receiving into the online system an indication of an edit to the suggested order. (par. 35-36,41—user input and updated purchase history)

[claim 31] Takahashi discloses a method of claim 18 additionally comprising the steps of: calculating a date that a prescription for the patient will expire (par. 33, 44); and

automatically generating an email message to the consumer indicating that the prescription will expire on the calculated date.(par. 44-45,53)

[claim 32] Takahashi discloses a method of claim 18 wherein the consumer and the patient are the same person. (par. 45, 538

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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